

Remarks/Arguments

Claim status. Claims 37, 38, 41 and 63-68 were previously pending in the case. Claims 63-68 are now in the case. Claims 37, 38, and 41 have been withdrawn.

Election under restriction requirement. The Office Action required restriction to one of the following inventions:

I. Claims 37, 38, and 41, drawn to methods of treating nerve damage comprising administering GDNF to a patient, classified in class 514, subclass 12.

II. Claims 63-68, drawn to methods of treating nerve damage comprising implanting cells that secrete GDNF to a patient, classified in class 424, subclass 93.1.

Applicants respectfully traverse and request reconsideration of the restriction requirement of the Office Action. In order to be fully responsive to the restriction requirement in the Office Action, the Applicants hereby elect Group II, Claims 63-68 for examination. Claims 37, 38, and 41 withdrawn hereby as directed to a non-elected group.

Grounds for Traverse. The Examiner argued that the inventions set forth in Groups I and II are distinct because the groups include methods that require “physically and functionally distinct elements, and possess[] different method steps and goals” as evidenced by their different classification (Office Action at page 2, section 2). The Examiner alleges that the search and examination for each group are not co-extensive and therefore the Examiner alleges that he would be unduly burdened if required to search and examiner the claims of Group I and Group II simultaneously. In response to these arguments presented by the Examiner in the Office Action, Applicants respectfully traverse and request reconsideration of the restriction requirement in view of the reasons set forth below.

35 U.S.C. §121 states that “[i]f two or more independent and distinct inventions are claimed in one application, the Director **may** require the application to be restricted to one of the inventions (emphasis added).” The statute, therefore, establishes restriction as a procedural matter within the discretion of the Patent and Trademark Office Director. MPEP §803 provides Examiners with guidance as to when restriction is proper. Section 803 states “that there are two criteria for a proper requirement for restriction between patentably distinct inventions: the inventions must be independent or distinct as claimed; **and** there must be **a serious burden** on the Examiner if restriction is required (emphasis added).”

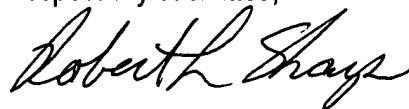
Although the Examiner concluded that the restriction was required for the present application under 35 U.S.C. §121, the Examiner failed to adequately support that conclusion in the Office Action. Instead, the Office Action provided broad and vague assertions that the groups defined were “distinct” from

each other and they have non-coextensive searches and considerations. The standard applied in the present case then is clearly contrary to the controlling law described previously that demands that a failure to restrict seriously burden the Examiner before a restriction is considered proper.

On these facts, Applicants respectfully submit that the Examiner has improperly restricted inventive subject matter into the groups shown above. The Applicants respectfully contend that a search for the elected Group 1 would necessarily overlap a search for Group 2 because the present invention (Group I and Group II) is limited to methods of treating neurodegeneration with GDNF. The only difference being that Group II includes a limitation wherein the GDNF is administered via a natural or cellular vectors. The inventions within the two groups are so closely situated that there would be no serious burden on the Patent Office if restriction is not required because teachings on this type of subject matter are readily identified with word based searches. The advanced state of information technology allows such searches to be rendered without unduly burdening the searching authority. Therefore, in the present case separate searches of divergent fields would not be necessary for a thorough examination. The fact that Group I and Group II rely on different methods of administration of GDNF does not negate the determinative issue here being one around the magnitude of burden on the Examiner.

Conclusion. In conclusion, Applicants assert that the Examiner did not adequately set forth reasons consistent with the law as outlined in MPEP §803 when imposing the restriction of the present application. For the foregoing reasons, the Applicants respectfully request the examiner to remove the restriction requirement regarding Groups 1 and 2, entry of all amendments, examination on the merits, and allowance of all claims.

Respectfully submitted,



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